Attorney Docket No. 9335-8CT PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:	Pollard et al.	Confirmation No.:	4002
Appn No.:	10/685,260	Group Art Unit:	3653
Filed:	October 14, 2003	Examiner:	M. Butler
For:	DEVICE TO COUNT AND DISPENSE ARTICLES		

Date: September 3, 2010

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. § 41.37

Sir:

This Appeal Brief is filed pursuant to the "Notice of Appeal to the Board of Patent Appeals and Interferences" filed on April 7, 2010.

REAL PARTY IN INTEREST

The real party in interest is Parata Systems, LLC, pursuant to an Assignment from the inventors to Nekton Research, LLC recorded at the U.S. Patent and Trademark Office on August 18, 2003 at reel number 014392 and frame number 0532, a subsequent Assignment from Nekton Research LLC to NewCount, LLC recorded at the U.S. Patent and Trademark Office on August 18, 2003 at reel number 014392 and frame number 0539, and a subsequent Assignment from NewCount LLC to Parata Systems, LLC recorded at the U.S. Patent and Trademark Office on August 13, 2003 at reel number 014392 and frame number 0524.

RELATED APPEALS AND INTERFERENCES

Appellants are aware of no appeals or interferences that would be affected by the present appeal.

STATUS OF CLAIMS

Claims 29-40, 47 and 48 are pending. Claims 29-40 and 47 stand rejected under Section 112, first paragraph. Thus, Claims 29-40 and 47 are the subject of this appeal.[1]

STATUS OF AMENDMENTS

The clams as appealed are in the form Appellant submitted with Appellants' paper dated November 18, 2009.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 29 is directed to a device (exemplified by device 10 – *see* **Figure 1**) for singulating articles from a bulk supply of such articles. The device comprises: a housing for holding articles to be singulated (exemplified by housing 11 – *see* **Figures 1** and **2** and page 4, line 28 to page 5, line 12); an exit channel (exemplified by exit channel 20 – *see* **Figures 1, 2** and **3A-3C** and page 5, line 22 to page 6, line 8) fluidly connected to the housing at an entry end, the entry end of the exit channel being configured in cross-section to permit the passage of only a single article at a time (exemplified by the article-orienting unit 30 – *see* **Figures 5A-5C** and page 7, line 10 to page 8, line 10), the exit channel including a forwardly-directed jet aperture (exemplified by jet aperture **26a** – *see* **Figure 3A** and page 6, lines 9-21) and a rearwardly-directed jet aperture (exemplified by jet aperture **27** – *see* **Figure 3A** and page 6, lines 15-21), the exit channel having walls of constant cross-section between the entry end and the rearwardly-directed jet aperture (exemplified by exit channel 20 – *see* **Figures 3A-3C**); a first positive pressure source (exemplified by pressure source **28** – *see* **Figure 2** and page 6, lines 22-25) fluidly connected to the forwardly-directed jet aperture; a second positive pressure source (also exemplified by pressure source **28** – *see* **Figure 2** and page 6, lines 22-25) fluidly connected to the rearwardly-directed jet aperture; and a controller (exemplified by controller **40** – *see* **Figure 2** and page 6, line 33 to page 7, line 9) operatively connected with the first and second positive pressure sources that selectively controls the application of positive pressure to the forwardly-directed jet aperture and the rearwardly-directed jet aperture.

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[1] The Action does not reject Claim 48 under Section 112 or on any other basis. Appellants have assumed that Claim 48 is allowable, although the Action does not so state explicitly. If Appellants' understanding is incorrect, Appellants request the right to comment subsequently on any rejection of Claim 48.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether Claims 29-40 and 47 were properly rejected under Section 112, first paragraph.

ARGUMENT

A. The Rejection

The outstanding Office Action dated January 7, 2010 (the Action) states that Claims 29-40 and 47 contain "subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Action at page 2. The Action further states that "[a]n exit having a constant cross-section between the entry end and the rearwardly-directed jet aperture is not disclosed within applicant's specification." *Id.* This findings lead the Action to reject Claims 29-40 and 47 under Section 112, first paragraph.

In response, Appellants concede that the specific words of Claim 29 describing the cross-section of the exit channel are not included in the specification. However, Applicants submit that the figures of the application support this recitation. It is settled law that the figures alone of a specification may adequately support a claim amendment without adding new matter. *Vas-Cath Inc. v. Mahurkar*, 935 F. 2d 1555, 1565 (Fed. Cir. 1991). The proper test for support in the disclosure is whether the drawings convey with reasonable clarity to those of ordinary skill in the art that the applicant has in fact invented the invention recited in the claims. *Id.* at 1566. As an example, in *In re Heinle*, 342 F.2d 1001, 1007 (CCPA 1965), the court found that a claim limitation that recited "approximately one-fourth of the circumference of said core", when the drawings indeed conformed to this recitation, did no not violate the rule against new matter and was erroneously rejected.

Applying the *Vas-Cath* and *Heinle* holdings to the present application, Appellants submit that the facts compel a reversal of the current rejection under Section 112, first paragraph. For example, **Figures 2** and **3A** (shown below) show that the channel 20 is of constant height between the entrance (shown just to the left of the arrowhead of line 30) and the rear jet aperture 27.

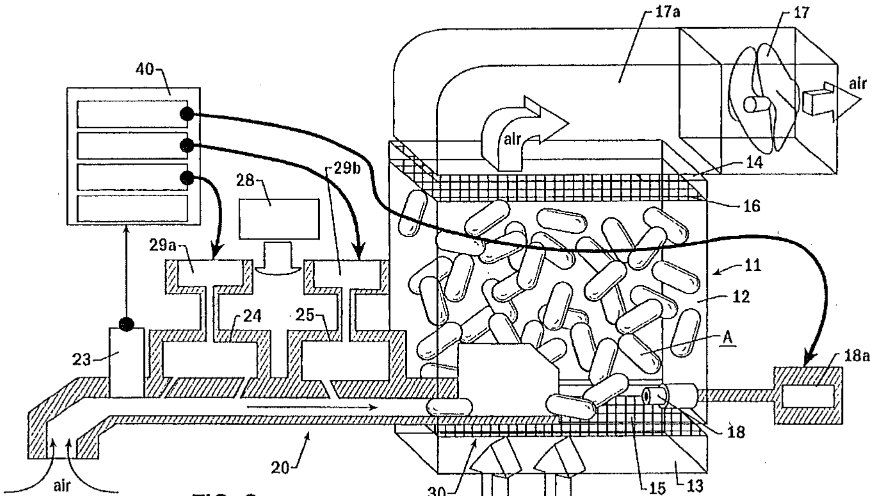

FIG. 2

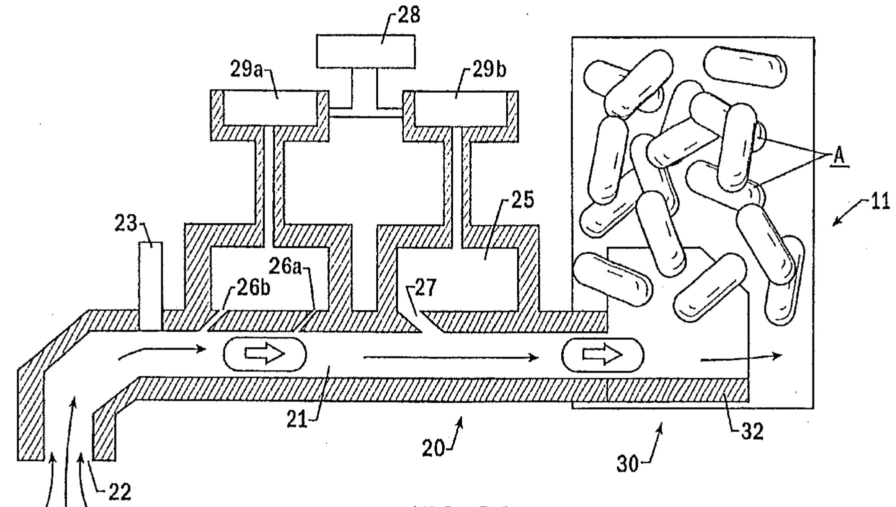

FIG. 3A

Figure 1 shows that the width and height of the channel 20 are constant in this area of the channel 20.

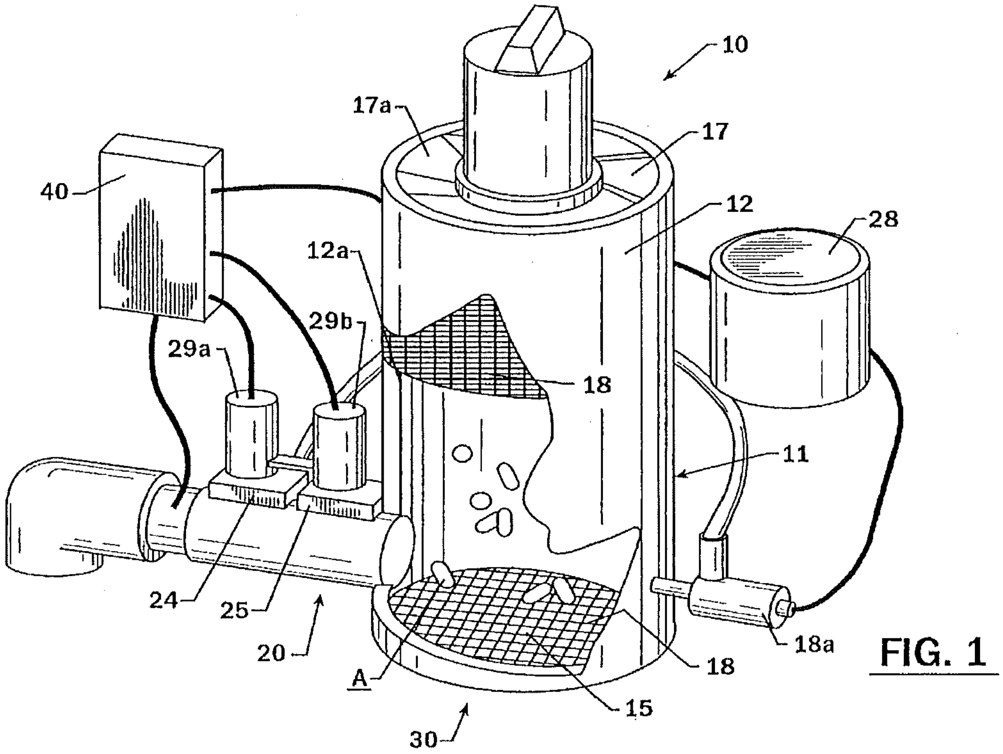

FIG. 1

As such, these figures would make it clear to one of ordinary skill in this art that the portion of the exit channel between the entry and the rear jet aperture 27 is of constant cross-section.

In addition, the exit channel 20 is discussed at page 6, lines 1-8 of the specification, which state:

> In the illustrated embodiment, the lumen 21 has a cross-section that permits the passage of only one article at a time; i.e., two or more articles may not travel in the lumen 21 side-by-side. Preferably, the lumen has a cross-section that generally resembles, but is somewhat larger than, that of the transverse cross-section of an article A traveling in the lumen 21. For example, the lumen 21 of the channel 20 can be sized to be generally rectangular in cross section, with a

> height or width dimension slightly smaller than two minimum dimensions α of the articles A (see FIGS. 4A and 4C) to prevent the simultaneous passage of two articles A.

This passage indicates that the lumen 21 of the channel is sized to receive only one article at a time. Notably, the lumen 21 runs the entire length of the exit channel. In order to prevent two articles from traveling side by side through the lumen, as stated in this first sentence of the quoted passage above, the cross-section would have to stay within the confines described in the second sentence of the quote throughout its length, generally resembling but being somewhet larger than the transverse cross section of an article A traveling in the lumen 21. The discussion of the cross-section of the lumen 21 never implies in the least that the cross-section would not be constant, but instead would be assumed to be constant by one of skill in this art.

Also, at page 10, lines 10-13 state:

> Also, **the inability of the exit channel 20 to permit the passage of more than one article A at a time at any single point in the exit channel 20** (i.e., the articles A cannot pass "side-by-side" through the exit channel 20) also assists the sensor 23 in distinguishing one article A from the next.

Again, this passage strongly implies a channel of constant cross-section, particularly when read in conjunction with the figures.

In view of the foregoing, Appellants submit that the figures of the specification, particularly when examined in combination with at least the above-cited passages, would convey to one of skill in this art that the cross-section of the exit channel between the entry and the rear jet aperture is constant. As held in *Vas-Cath*, the figures alone may be used to provide support for a claim recitation. Similar to *Heinle*, the figures of the present specification meet the recitation of Claim 29 regarding the cross-section of the exit channel. The specification is entirely consistent with a recitation that the channel is of constant cross-section. Appellants firmly believe that one of skill in this art would have presumed an exit channel of constant cross-section based on the figures and the specification. As such, Appellants respectfully request that the rejection under Section 112, first paragraph be reversed.

CONCLUSION

On the entire record and in view of all the cited references, Appellants submit that Claims 29-40 and 47 are patentable under Section 112, first paragraph. Accordingly, it is respectfully requested that the Examiner's conclusions be reversed, and that this case be passed to issuance.

Respectfully submitted,

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CERTIFICATION OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on September 3, 2010.

Joyce Paoli
Joyce Paoli

APPENDIX OF CLAIMS

Claims 1-28 are canceled.

29. (previously presented) A device for singulating articles from a bulk supply of such articles, comprising:

a housing for holding articles to be singulated;

an exit channel fluidly connected to the housing at an entry end, the entry end of the exit channel being configured in cross-section to permit the passage of only a single article at a time, the exit channel including a forwardly-directed jet aperture and a rearwardly-directed jet aperture, the exit channel having walls of constant cross-section between the entry end and the rearwardly-directed jet aperture;

a first positive pressure source fluidly connected to the forwardly-directed jet aperture;

a second positive pressure source fluidly connected to the rearwardly-directed jet aperture; and

a controller operatively connected with the first and second positive pressure sources that selectively controls the application of positive pressure to the forwardly-directed jet aperture and the rearwardly-directed jet aperture.

30. (previously presented) The device defined in Claim 29, further comprising a sensor operatively associated with the controller that detects articles passing through the exit channel.

31. (previously presented) The device defined in Claim 29, further comprising a second forwardly-directed jet aperture located downstream of the rearwardly-directed jet aperture, the second forwardly-directed aperture being fluidly connected with a third positive pressure source and with the controller.

32. (previously presented) The device defined in Claim 31, wherein the first, second and third positive pressure sources are coincident.

33. (previously presented) The device defined in Claim 29, wherein the first and second positive pressure sources are coincident.

34. (previously presented) The device defined in Claim 29, wherein the housing includes a jet aperture directed toward the exit channel, the jet aperture being fluidly connected to a fourth positive pressure source, the fourth positive pressure source being operatively connected to the controller.

35. (previously presented) The device defined in Claim 29, wherein the housing includes a floor and an opposing ceiling, and wherein the floor includes a first foraminous member and the ceiling includes a second foraminous member.

36. (previously presented) The device defined in Claim 29, further comprising an article-orienting member positioned upstream of the exit channel.

37. (previously presented) The device defined in Claim 29, wherein said first positive pressure source and said forwardly-directed jet aperture are configured to direct a jet of between about 1 and 500 psi into the exit channel.

38. (previously presented) The device defined in Claim 29, wherein said second positive pressure source and said rearwardly-directed jet aperture are configured to direct a jet of between about 1 and 500 psi into the exit channel.

39. (previously presented) The device defined in Claim 34, wherein the housing jet aperture and the fourth positive pressure source are configured to direct a jet of between about 1 and 500 psi toward the exit channel.

40. (previously presented) The device defined in Claim 29, further comprising a plurality of substantially identical articles to be singulated, the articles being stored in the housing.

Claims 41-46 are canceled.

47. (previously presented) The device defined in Claim 29, wherein the housing includes a floor and an opposing ceiling, and wherein the floor includes at least one air intake hole.

48. (previously presented) A device for singulating articles from a bulk supply of such articles, comprising:

a housing for holding articles to be singulated;

an exit channel fluidly connected to the housing at an entry end, the entry end of the exit channel being configured in cross-section to permit the passage of only a single article at a time, the exit channel including a forwardly-directed jet aperture and a rearwardly-directed jet aperture;

wherein the housing includes a floor and an opposing ceiling, and wherein the floor includes at least one air intake hole.

a first positive pressure source fluidly connected to the forwardly-directed jet aperture;

a second positive pressure source fluidly connected to the rearwardly-directed jet aperture; and a controller operatively connected with the first and second positive pressure sources that selectively controls the application of positive pressure to the forwardly-directed jet aperture and the rearwardly-directed jet aperture.

EVIDENCE APPENDIX

NONE

RELATED PROCEEDINGS APPENDIX

NONE